

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael A. Halter, et al.
Patent No.: 7,615,939
Serial No.: 10/802,277
Issued: November 10, 2009
Filing Date: March 17, 2004
For: SPECTRALLY CALIBRATABLE
MULTI-ELEMENT RGB LED LIGHT SOURCE
Attorney Docket: 57108/367051

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT DETERMINATION

Sir:

1. Applicants filed a Communication Regarding Patent Term Adjustment (PTA) Indicated in Notice of Allowance (hereinafter "Communication") on April 27, 2009, a copy of which is attached hereto as Attachment A. In the Communication Applicants asserted that the PTA of 1174 days that was set forth in the Notice of Allowance, mailed April 3, 2009, was erroneous. At that time, Applicants believed that the correct total PTA due was 1515 days.

2. In response to the Communication, the United States Patent and Trademark Office issued, on October 7, 2009, a decision **held in abeyance** until after the

actual patent date (hereinafter “USPTO Response”). A copy of the USPTO Response is attached hereto as Attachment B.

3. The actual patent issued November 10, 2009. It is believed that the total PTA is still erroneous and that the correct total PTA is 1546 days.

4. Accordingly, Applicants submit this Renewed Request for Reconsideration of Patent Term Adjustment Determination under 37 C.F.R. § 1.705(d) and pursuant to page 2 of the USPTO response, requesting that the United States Patent & Trademark Office reconsider and correct the PTA due.

5. The determination of the total PTA days is erroneous because the United States Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 1174 days provided to this application only accounts for one of the delays of the PTO – the “A Delay.” The other delay warrants an additional PTA credit of 418 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) – the “B Delay.” Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1592 days (*i.e.*, 1174 days + 418 days) is appropriate based upon the PTO delay. The total number of PTA debits of 46 days for applicant delay that is set forth on the PTA History (*See* Exhibit A of Attachment A) is correct. Thus, the correct total PTA to date is 1546 days (*i.e.*, 1592 days minus 46 days).

6. Thus, Applicants believe that the total PTA credit for PTO delay is 1592 days, the total PTA debit for applicant delay is 46 days, and the total PTA under § 1.703(f) is 1546 days.

7. In accordance with 1.705(d), this application for patent term adjustment is filed within two (2) months from the issue date of the patent.

8. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

i) The correct total PTA credit is 1220 days (not counting Applicant's delay, discussed further herein).

ii) The basis for the 1220 days PTA credit is under §§ 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 U.S.C. § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 418 days is under § 1.702(b) and is due to the PTO's failure to issue a patent within three years of the filing date.

9. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

i) The relevant dates as specified in § 1.703(a) for one part of the PTA credit are as follows:

(a) The date of May 18, 2005, which is the date that is the day after fourteen months after the date on which the application was filed under 35 U.S.C. § 371(c), and September 18, 2008, the date of mailing of a Non-Final Office Action. Thus, this period of delay runs from May 18, 2005 to September 18, 2008. This period of delay is 1220 days.

Thus, the total period of delay for this part of the PTA credit is 1220.

ii) The relevant dates as specified in § 1.703(b) for the other part of the PTA credit are as follows:

(a) the date of March 18, 2007, which is the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 371(c) and the date of November 10, 2009, which is the date the patent issued. Thus, the period of delay runs from March 18, 2007 to November 10, 2009. This period of delay is 968 days, minus the overlap period beginning on March 18, 2007 and ending on September 18, 2008, the overlap being 550 days (i.e., 968 days minus 550 days = 418 days).

Thus, the total period of delay for this part of the PTA credit is 418 days.

iii) The total PTA under § 1.703(f) is 1542 days, which is the total PTA credits for PTO delay of 1174 days plus 418 days less the total PTA debits for applicant delay of 46 days.

10. The patent is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

11. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A):

i) The Response after Non-Final Office Action was filed February 2, 2009 with a Petition for Extension of Time. The period of adjustment for delay associated with this reply begins on the day after the date that is three months after the

date of mailing of the Non-Final Office Action on September 19, 2008 and ends on the date the response was filed. Thus, the period of delay runs from December 19, 2008 to February 2, 2009. This period of delay is 46 days.

12. No fees are believed due for this renewed request based on the payment of the fees under 37 C.F.R. § 1.18(e) with the submission of the First Communication, and the United States Patent and Trademark Office's statement in the USPTO Response that no further fees are required. See USPTO Response, page 3.

13. Applicants respectfully request the PTA determined by the United States Patent and Trademark Office be reconsidered and corrected.

Respectfully submitted,

Date: 12/14/09



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U.S. Patent No. 7,615,939
Issued: November 10, 2009
RENEWED REQUEST FOR CONSIDERATION OF
PATENT TERM ADJUSTMENT DETERMINATION

ATTACHMENT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------------------------|---|------------------------|
| In re Application of: |) | |
| |) | |
| M. Halter |) | Group Art Unit: 2821 |
| |) | |
| Serial No.: 10/802,277 |) | Examiner: H. Philogene |
| |) | |
| Filed: March 17, 2004 |) | |
| |) | |
| For: SPECTRALLY CALIBRATABLE |) | |
| MULTI-ELEMENT RGB LED |) | |
| LIGHT SOURCE |) | |

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Attorney Docket No. 57108/367051

Communication Regarding Patent Term Adjustment (PTA)
Indicated in Notice of Allowance

Sir:

1. A Notice of Allowance was mailed on April 3, 2009 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) (attached as Exhibit A), indicating that the total PTA due is 1174 days. It is believed that the correct total PTA to date is actually 1515 days.

2. In accordance with 37 C.F.R. § 1.705(b), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance. It is accompanied by (1) the required fee set forth in 1.18(e); and (2) the required statement of facts and the bases for adjustment.

3. The determination of the total PTA is erroneous because the U.S. Patent and Trademark Office's (PTO) PTA calculator failed to account for the delay under 35 U.S.C. § 154(b)(1)(B) ("B delay"), which guarantees no more than a three-year application pendency. The two PTO delays (the "A delay" and the "B delay") should be added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, 580

F.Supp. 2d 138 (Fed. Cir. 2008). Any overlap between the A Delay and the B Delay should also be subtracted in accordance with *Wyeth*. Applicants' delay should then be subtracted from that total in accordance with 35 U.S.C. § 154(b)(2)(A).

4. "A Delay." Applicants agree with the calculation of 1174 days stated on the attached PTA History, showing a PTO Delay ("A delay") of 1220 days (which is the number of days beginning on the day after the date that is fourteen months after the date on which the application was filed and ending on the date of mailing of an action). However, this only accounts for one of the delays of the PTO.

"B Delay." The other delay ("B delay") warrants a credit totaling 341 additional days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Pursuant to 37 C.F.R. § 1.703(b) (and as outlined on the below chart), this is the number of days from the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) (which was March 17, 2004) and ending on the date a patent issued (which is calculated potentially as being August 25, 2009¹) (891 days) minus the overlap between the A Delay period and the B Delay period (550 days). The result is 341 additional days due (calculated using the duration between the two dates from <http://www.timeanddate.com/date/dateadd.html>), and the correct total PTA credit that should be awarded for this "B delay" is 341 days. The PTA History incorrectly ignored the "Three Years" portion of the PTA calculation, indicating "-" for the Three Year Delay.

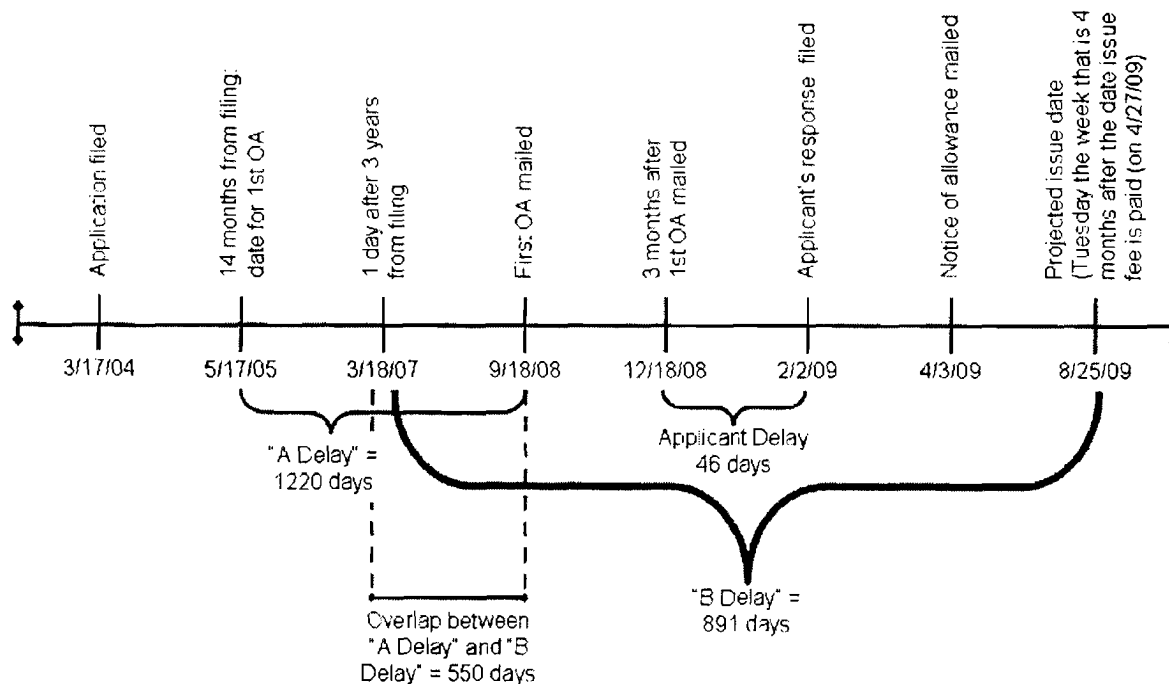
5. Applicants agree with the calculated Applicant Delay of 46 days. The following statement is required by 37 C.F.R. 1.705(b)(2)(iv)(A):

The Response after Non-Final Action filed February 2, 2009 was filed after the three month period for filing a response. Under 37 C.F.R. 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is

¹ For the issue date calculation, Applicants have used the date that issue fee is being paid, 4/27/09, and assumed the patent will issue the Tuesday of the week that is four months from the date of payment of the issue fee, which would be August 25, 2009.

three months after the date of mailing of the September 18, 2008 Office Action and ends on the date that the reply was filed. Thus, the period of delay runs from December 18, 2008 to February 2, 2009. This period of delay is calculated by the PTO as 46 days.

6. Applicants believe that the total PTA credit should thus be 1515 days. This is the total of the PTO A Delay (1220 days) + B Delay (891 days) minus the overlap between the "A Delay" and "B Delay" periods (550), minus Applicants' delay (46 days) = 1515 total days. The below chart reflects Applicants' reasoning and shows the relevant dates at issue:



8. Any patent granted on this application is not subject to a terminal disclaimer. *See* 37 C.F.R. § 1.705(b)(2)(iii).

The Commissioner is authorized to charge any additional fees that may be due or credit any overpayment to Deposit Account No. 11-0855.

Respectfully submitted,



Dean W. Russell
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Attorney for Assignee

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Attachment: Exhibit A – Copy of PTA History for this Application

Exhibit A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 5500
Arlington, Virginia 22203-1500
www.uspto.gov

| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO |
|--|-------------|----------------------|--------------------|-----------------|
| 10/802,277 | 03/17/2004 | Michael A. Heller | 10990-52343 B | 4211 |
| 21159 | 7590 | 6406/07/04 | EXAMINER | |
| JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET SUITE 2800 ATLANTA, GA 30309 | | | PHILIPPE, HAÏSSA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2621 | |
| DATE MAILED: 04/03/2009 | | | | |

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 1174 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 1174 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

10/802,277 SPECTRALLY CALIBRATABLE MULTI-ELEMENT RGB LED LIGHT SOURCE 04-20-2009:09:22:33

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/802,277

| | | | |
|------------------------------|------------|--------------------------------------|------|
| Filing or 371(c) Date: | 03-17-2004 | USPTO Delay (PTO) Delay (days): | 1220 |
| Issue Date of Patent: | - | Three Years: | - |
| Pre-Issue Petitions (days): | +0 | Applicant Delay (APPL) Delay (days): | 46 |
| Post-Issue Petitions (days): | +0 | Total PTA (days): | 1174 |
| USPTO Adjustment(days): | +0 | Explanation Of Calculations | |

Patent Term Adjustment History

| Date | Contents Description | PTO(Days) | APPL(Days) |
|------------|---|-----------|------------|
| 04-03-2009 | Mail Notice of Allowance | | |
| 03-31-2009 | Document Verification | | |
| 03-31-2009 | Notice of Allowance Data Verification Completed | | |
| 03-31-2009 | Case Docketed to Examiner in GAU | | |
| 03-10-2009 | Date Forwarded to Examiner | | |
| 02-02-2009 | Response after Non-Final Action | | 46 |
| 02-02-2009 | Request for Extension of Time - Granted | | + |
| 10-20-2008 | Change in Power of Attorney (May Include Associate POA) | | + |
| 10-16-2008 | Correspondence Address Change | | + |
| 09-18-2008 | Mail Non-Final Rejection | 1220 ✓ | |
| 09-15-2008 | Non-Final Rejection | + | |
| 03-17-2004 | Information Disclosure Statement considered | + | |
| 03-21-2008 | Case Docketed to Examiner in GAU | + | |
| 03-06-2008 | Case Docketed to Examiner in GAU | + | |
| 03-06-2008 | Case Docketed to Examiner in GAU | + | |
| 01-16-2008 | Case Docketed to Examiner in GAU | + | |
| 12-19-2007 | Case Docketed to Examiner in GAU | + | |
| 08-27-2007 | Request for Classification Division Decision | + | |
| 03-17-2004 | Information Disclosure Statement (IDS) Filed | + | |
| 07-13-2007 | Transfer Inquiry to GAU | + | |
| 06-09-2007 | Transfer Inquiry to GAU | + | |
| 06-09-2007 | Transfer Inquiry to GAU | + | |
| 03-18-2007 | Transfer Inquiry to GAU | + | |
| 12-13-2006 | Transfer Inquiry to GAU | + | |
| 03-17-2005 | Reference capture on IDS | + | |
| 10-12-2005 | Transfer Inquiry to GAU | + | |
| 05-26-2005 | Transfer Inquiry to GAU | + | |
| 10-01-2004 | IFW TSS Processing by Tech Center Complete | + | |
| 09-09-2004 | Reference capture on IDS | + | |
| 09-09-2004 | Information Disclosure Statement (IDS) Filed | + | |
| 09-09-2004 | Information Disclosure Statement (IDS) Filed | + | |

| | | |
|------------|--|---|
| 08-31-2004 | Application Return from OIPE | ↑ |
| 08-31-2004 | Application Return TO OIPE | ↑ |
| 08-31-2004 | Application Dispatched from OIPE | ↑ |
| 08-31-2004 | Application Is Now Complete | ↑ |
| 08-03-2004 | Additional Application Filing Fees | ↑ |
| 08-03-2004 | Applicant has submitted new drawings to correct Corrected Papers problems | ↑ |
| 06-03-2004 | Corrected Paper | ↑ |
| 04-13-2004 | Cleared by OIPE CSR | ↑ |
| 04-02-2004 | IFW Scan & PACR Auto Security Review | ↑ |
| 03-17-2004 | Initial Exam Team on | ↑ |

Close Window

U.S. Patent No. 7,615,939
Issued: November 10, 2009
RENEWED REQUEST FOR CONSIDERATION OF
PATENT TERM ADJUSTMENT DETERMINATION

ATTACHMENT B



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

MAILED

OCT 07 2009

OFFICE OF PETITIONS

In re Application of :
MICHAEL A. HALTER :
Application No. 10/802,277 : ON APPLICATION FOR
Filed: March 17, 2004 : PATENT TERM ADJUSTMENT
Atty. Docket No. 16990-52545-B :

This is in response to the Communication Regarding Patent Term Adjustment (PTA) Indicated in Notice of Allowance filed April 27, 2009, which is properly treated under 37 CFR 1.705(b). Applicant submits that the correct patent term adjustment to be indicated on the patent is one thousand five hundred fifteen (1,515) days, not one thousand one hundred seventy-four (1,174) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant seeks this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined.

Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

¹ For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions